

GFThe opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN M. EGNOR

Appeal No. 2001-0043
Application 08/828,560

ON BRIEF

MAILED

SEP 26 2001

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before COHEN, PATE, and BAHR, **Administrative Patent Judges.**

PATE, **Administrative Patent Judge.**

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-12.
These are the only claims in the application.

The claimed invention is directed to a wheel stop for a commercial kitchen apparatus.

The appealed subject matter may be further understood with reference to claims 1 and 12 appended to appellant's brief.

Appeal No. 2001-0043
Application 08/828,560

The references of record relied upon by the examiner as evidence of obviousness are:

Wilson et al. (Wilson)	2,007,514	Jul. 9, 1935
Rapp	2,870,872	Jan. 27, 1959
Gregg	2,441,627	May 18, 1998

Rejections

Claims 1, 2, 6/1, 7, 10, 11, and 12 are rejected under 35 U.S.C. § 103 as unpatentable over Gregg in view of Rapp.

Claims 3, 4, 5, 6/3, 6/4, 8 and 9 are rejected under 35 U.S.C. § 103 as unpatentable over Gregg in view of Rapp and Wilson.

For an exposition of these rejections, reference is made to the examiner's answer mailed May, 24, 2001 for the full details thereof. Appellant's arguments with respect thereto are found in detail in the appeal brief of March 2, 2001.

Opinion

We have carefully evaluated the claimed subject matter on appeal. As a result of this review, we have determined that the claims are so indefinite that the prior art could not be compared thereto. Consequently, we reverse the section 103 rejections on appeal and enter our own rejection under 35 U.S.C. § 112, second paragraph, pursuant to 37 CFR 1.196(b).

In our review of the claimed subject matter, we note the following errors or inaccuracies that render the claimed subject matter indefinite within the purview of 35 U.S.C. § 112, second paragraph.

In claim 1, it is recited that the subject matter "stop" with "a solid rigid body" has a "rear ramp portion extending rearwardly from the rearwardly sloping surface of the front ramp portion. . . ." Next, it is recited that there is a "wheel receiving portion positioned between the front and rear ramp portions. . . ." It is not seen how the rear ramp portion can extend from the front ramp portion, if in fact, a wheel receiving portion is juxtaposed therebetween. This inconsistency renders claim 1 indefinite.

It is noted that the claim calls for a standard of a certifying body, the National Sanitary Foundation. While reference to codes and official specification is permissible in a claim, the specific code or standard must be clearly articulated so that one endeavoring to determine what exactly infringes the claim can ascertain the metes and bounds of the claimed subject matter. The example most familiar is a reference to ASTM standards in claimed subject matter. In such a situation, the

specific ASTM test specification is required for the claim to be definite under 35 U.S.C. § 112, second paragraph.

Turning to claim 12 on appeal, the claimed subject matter therein recited has numerous errors and inconsistencies. First, there is a reference to "the article" in line 2 of the claim as it appears appended to the brief. No article has been previously recited. It is unclear whether this article refers to the commercial kitchen equipment of line 1. In line 3, there appears the recitation "which comprises" which normally would be introductory of process limitations or steps in a process claim. Instead such a phrase introduces "wheels of the article." The phrase "wheels of the article" has apparently little to do with the subject matter in the claim that precedes or follows it. It is unclear if the next following clause "by confining the wheels . . ." is the first process limitation of the method claim. In the first line of the next page of the appendix "the wheel" singular is recited. If this is one of the previously recited wheels the claim should so indicate. After "wheel" in the first line, "and opposed spaced ramps" appears. If punctuation were provided between the word "wheel" and "opposed spaced ramps" it might be understood that a new structure was being recited. However, as it appears now, the wheel support element of the

prior page may be required to be spaced slightly further than the width of the wheel and opposed spaced ramps. Interpreted in this way, the opposed spaced ramps would not have been previously recited and would lack all antecedent basis. If this interpretation of the claim were correct, the claim would be misdescriptive of the actual width of the, as still unnamed, device composed of the wheel support elements and opposed spaced ramps. The fourth line on this page has the recitation "by application of a displacing force to such an article. . . ." As noted previously, the article has not been previously defined. Additionally, it is unclear to what the prepositional phrase, "by application . . ." refers. Next, it is unclear whether the recitation of "such a ramp" refers back to the opposed spaced ramps or not, and does the recitation of "up a ramp" (line 6) refer to a new ramp or one previously recited. Likewise, to what does the term "the stop" in the ultimate line refer? No stop has been previously recited.

Additionally, it is difficult to determine what are the actual method steps intended to be claimed by appellant. It is suspected that the steps are the claim clauses that begin with the word "by." However, claim interpretation should be based on more than suspicion. Appellant's failure to use positive, active

Appeal No. 2001-0043
Application 08/828,560

steps or gerunds to describe steps in the claim renders the claim indefinite within the preview of 35 U.S.C. § 112, second paragraph. As this Board stated in *Ex parte Erlich*, 3 USPQ2d 1011, 1017 (Bd Pat App&Int 1986):

While we agree with appellants that the claims need not recite all of the operating details, we do find that a method claim should at least recite a positive, active step(s) so that the claim will "set out and circumscribe a particular area with a reasonable degree of precision and particularity," *In re Moore*, 58 CCPA 1042, 439 F.2d 1232, 169 USPQ 236 (1971), and make it clear what subject matter these claims encompass, *In re Hammack*, 57 CCPA 1225, 1230, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (1970), as well as making clear the subject matter from which others would be precluded, *In re Hammack, supra*, 57 CCPA at 1231, 427 F.2d at 1382, 166 USPQ at 208.

Finally, our remarks respecting the NSF sanitation standards with respect to claim 1, applies equally well to claim 12.

All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious--the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Our analysis of the claims indicates that considerable speculation as to the meaning of the terms employed and assumptions as to the scope of such claims needs to be made. We do not think a rejection under 35 U.S.C. § 103 should be based

Appeal No. 2001-0043
Application 08/828,560

on such speculations and assumptions. *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962); *Ex parte Head*, 214 USPQ 551 (Bd Pat App&Int 1981). Accordingly, we reverse the rejections under 35 U.S.C. § 103 and enter one under section 112, second paragraph. We must emphasize that such a reversal is a technical reversal, in the sense that we have not as yet ascertained the patentability of the claims over the prior art. The claims are merely too indefinite for us to do so.

Rejection Under 37 CFR 1.196(b)

Claims 1-12 are rejected under 35 U.S.C. § 112, second paragraph as indefinite. The reasons for the rejection are stated above.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of

Appeal No. 2001-0043
Application 08/828,560

rejection to avoid termination of proceedings (§ 1.197(c)) as to
the rejected claims:

(1) Submit an appropriate amendment of the claims
so rejected or a showing of facts relating to the
claims so rejected, or both, and have the matter
reconsidered by the examiner, in which event the
application will be remanded to the examiner. . . .

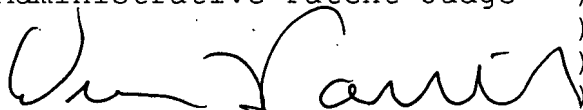
(2) Request that the application be reheard under
§ 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED/37 CFR § 1.196(b)

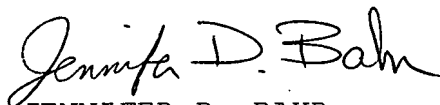


IRWIN CHARLES COHEN)
Administrative Patent Judge)



WILLIAM F. PATE, III)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES



JENNIFER D. BAHR)
Administrative Patent Judge)

WFP:pgg

Appeal No. 2001-0043
Application 08/828,560

Timothy W. Chell
28 Cooper Street
Woodbury, NJ 08096